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35

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/922,263 09/02/97 CROWLEY

R BSC011

QM12/0313

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EXAMINER

SHAY, D

ART UNIT

PAPER NUMBER

3739

19

DATE MAILED:

03/13/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/922,263

Applicant(s)

Crowley

Examiner

d. sh

Group Art Unit

3739

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE —3— MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on December 9, 1999
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1, 3-12, 14-17, 20-30, 32-44, & 47-50 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1, 3-12, 14-17, 20-30, 32-44, & 47-50 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of Reference(s) Cited, PTO-892
- ☒ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3-9, 12, 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

These claims are indefinite as depending from cancelled claims for the purposes of examination claim 14 will presumed to depend from claim 10, claims 3, 8, and 12 will be considered to depend from claim 1.

Claims 1, 5-8, 10-12 and 15-17 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Takayama et al.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 4, 9, 14, 20-30, 32-44, and 47-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takayama et al in combination with Chapelon et al ('526). The teachings of Takayama are as set forth previously. Chapelon et al teach the equivalence of configuring applicators for extracorporeal or intracorporeal use. It would have been obvious to configure the

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device of Takayama et al for intracorporeal use by substituting the pressure wave generator of Chapelon et al ('526), since this lends itself ^{intracorporeal} ~~intrapexial~~ application, as taught by Chapelon and to ~~dm~~ use the particular pressure generating crystal and various beam directing elements or other housing modifications, since these are well known ⁱⁿ in the art, as well as to employ any of the ~~dm~~ other light sources claimed, since these are equivalents and can be used for tissue identification via reflectance transmittance fluorescence, or Raman spectra. Official notice of all of the foregoing having been taken, and the notoriousness in the art of the use of such sources as officially noticed being shown by the supplied references, thus producing a device such as claimed.

Applicant argues, regarding Takayama et al, that the intended use of Takayama et al device is different from that of applicant. The Examiner respectfully notes that each and every structural element of the claims to which Takayama et al are applied under 35 U.S.C. 102 is found therein. As already set forth in the previous Office Action there is nothing in the structure of Takayama et al that would prevent the device from "placement inside the body" if an incision were made in the body. The Examiner further notes that bodies come in a wide variety of sizes.

The arguments drawn to the combination applied in the obviousness rejection are moot in view of the new grounds of rejection. Regarding the arc lamp, fluorescent light source, spark gap light source and incandescent lamp being known, the Examiner respectfully notes Kittrell et al ('106) submitted as reference AAR by applicants. Kittrell et al indisputably show the combination of tissue treatment and diagnostic devices in a single catheter, noting that the diagnostic light source may be "light from conventional sources" (see column 20, lines 57-58).

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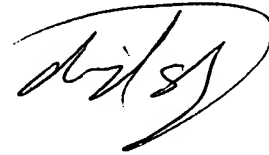
The Examiner notes that arc lamps, fluorescent lamps, sparks gap module and incandescent lamps are all conventional light sources.

Applicant's arguments filed December 9, 1999 have been fully considered but they are not persuasive.

Applicant's arguments with respect to claims 3, 4, 9, 14, 20-30, 32-44 and 47-50 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication should be directed to David Shay at telephone number (703) 308-2215.

David Shay:bhw
March 1, 2000

A handwritten signature in black ink, appearing to read 'D. M. Shay', enclosed within a large, loopy oval stroke.

DAVID M. SHAY
PRIMARY EXAMINER
GROUP 380